

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 40, 41, 42, and 43 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 1-43 are now pending in this application. Claims 1 and 40-43 are the independent claims.

I. The Anticipation Rejection

Claims 1-32, 35, and 39-43 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Burgan (U.S. Patent No. 6,459,892) was cited. This rejection is respectfully traversed.

Burgan fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d

1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

Specifically, claims 1, from which each of claims 2-39 depends, and claims 40 and 41 recite “obtaining information regarding at least one state variable **not indicative of** chat server status, **chat group status**, or chat message status”. Burgan does not expressly or inherently teach or suggest “obtaining information regarding at least one state variable **not indicative of** chat server status, **chat group status**, or chat message status”.

Instead, Burgan allegedly recites “[w]hen a **subscriber account** is not active, the process returns to the standby operation of Step 58. When the **subscriber account** is active, in Step 136 the chat server 48 sends a list of active chats along with the group address for each active chat to the requester.” See col. 8, lines 5-9. Accordingly, it is respectfully submitted that the rejection of each of claims 1, 40, and 41 is unsupported by Burgan and should be withdrawn. Also, the rejection of each of claims 2-39, each ultimately depending from independent claim 1, is unsupported by Burgan and also should be withdrawn.

Each of claims 42 and 43 recite “detecting a chat trigger **not indicative of** chat server status, chat group status, or chat **message status**”. Burgan does not expressly or inherently teach or suggest “detecting a chat trigger **not indicative of** chat server status, chat group status, or chat **message status**”.

Instead Burgan allegedly recites the “the chat server 48 sends a start up **message** to each user in the subscriber list. The start up **message** creates an inbox with the new chat topic on the subscriber’s device ... the chat server 48 sends an introduction **message** including information about the new chat topic such as the originator and other subscribers”. See col. 6, lines 17-24.

II. The Obviousness Rejection

Claims 33-34 and 36-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Burgan (U.S. Patent No. 6,459,892) and/or Bogard (U.S. Patent No. 6,757,365). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See MPEP § 2143.

Applicant respectfully submits that Bogard is not properly available as a reference. Application 09/759,282 claims priority to co-pending applications:

“Method and System for Mobile Chat Sessions”, Ser. No. 09/666,564 (Attorney Docket No. 2685-5678), filed 21 September 2000; and

“Method and System for Mobile Chat Sessions”, Ser. No. 09/666,565 (Attorney Docket No. 2685-5705), filed 21 September 2000.

The filing date of Bogard is 16 October 2000, which is after the priority date of Applicant’s pending application. As such, Bogard cannot be used as a reference.

As stated above, Burgan does not expressly or inherently teach or suggest “obtaining information regarding at least one state variable not indicative of chat server status, chat group status, or chat message status”. Even if Bogard were available as a reference, Bogard does not overcome the deficiencies of Burgan.

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references fail to establish a *prima facie* case of obviousness.

Consequently, reconsideration and withdrawal of each of the rejections of claims 33-34 and 36-38 is respectfully requested.

CONCLUSION


It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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